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**FEB 8 2002**  
**CANCELLED**  
**OFFICE OF PETITIONS**

In re Application of  
Cleary et al.  
Application No. 09/681,968  
Filed: 30 June, 2001  
Attorney Docket No. CEL-97

: DECISION REFUSING STATUS  
: UNDER 37 CFR 1.47(a)  
:  
:  
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This is a decision on the petition filed under 37 CFR 1.47(a)<sup>1</sup> filed on 22 January, 2002.

The petition is **DISMISSED**

Petitioner is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time under 37 CFR 1.136(a) are permitted.

On 30 June, 2001, the application was filed without an executed oath or declaration.

Accordingly, on 11 July, 2001, Initial Patent Examination Division mailed a "Notice to File Missing Parts of Application" requiring a signed oath or declaration and a surcharge for its

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<sup>1</sup>A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign, accordingly the petition will be treated as a petition under 37 CFR 1.47(a).

late filing. A two (2) month period for reply was set. In response, on 22 January, 2002 (certificate of mailing date 13 November, 2001), petitioners filed a declaration naming Michael J. Cleary, Cathy R. Faulkner, Jason R. Hall, Mario A. Hernandez, and Richard L. White as joint inventors, and signed by all joint inventors except Hall on behalf of themselves and joint inventor Hall, the present petition and a request for a two (2) month extension of time to reply to the Notice mailed on 11 July, 2001.

Petitioners assert that a letter was mailed to Hall, requesting that he sign the declaration, but Hall has refused to sign and return the declaration. In support, petitioners submit a Certified Mail Return Receipt postcard showing Hall's signature.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2) above.

In regards to item (1), petitioner has not provided sufficient proof that a copy of the application (specification including claims, drawings, if any, and Declaration) was sent or given to the non-signing inventor for review.<sup>2</sup> The petition simply states that a request to sign the declaration was sent to Hall. It is unclear whether that request included a copy the application. Additionally the petition states that a copy of the letter sent to Hall is included therewith. A review of the official file reveals that no transmittal letter was received with the petition filed on 22 January, 2002, however.

Petitioners may show proof that the application (specification, including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor by providing, with any renewed petition, a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first

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<sup>2</sup>MPEP 409.03(d).

hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers.<sup>3</sup> If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), petitioner has not submitted a proper oath or declaration in compliance with 37 CFR 1.63. The declaration filed on 22 January, 2002, does not state that the person(s) making the oath or declaration acknowledge the duty to disclose to the Office all information known to the person(s) to be material to patentability as defined in 37 CFR 1.56. Rather, the declaration filed on 22 January, 2002, incorrectly acknowledges a duty to disclose all information material to examination of the application. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 must be submitted with any renewed petition.

Counsel's deposit account, No. 50-1285, will be charged the petition fee and surcharge as authorized in the petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

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<sup>3</sup>Id.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6918.



Douglas I. Wood  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy